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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,667	10/23/2000	Julie B. Madison	LERNER1.024C2	9829

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EXAMINER

DANG, HUNG XUAN

ART UNIT PAPER NUMBER

2873

DATE MAILED: 06/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/694,667

Applicant(s)
Madison

Examiner
Hung X. Dang

Art Unit
2873



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 19, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-50 and 59-89 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-50 and 59-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. The amendment filed on 3/19/02 have been entered.

Claims Rejection Under 35 USC - 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 83-89 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Chao** (5,568,207).

Chao discloses the detachable sunglasses with magnet which comprises a primary lens frame (10) and auxiliary lens frame (20), the primary spectacle frame (10) includes two temples (12) pivotally coupled to two side extensions (11) and includes two magnetic members (14) secure in the extensions, the auxiliary spectacle frame (20) includes two legs (21) engaged on the primary spectacle frame and each having a magnetic member (22) for engaging with the magnetic members (14) of the primary spectacle frame. (See figures 3, 4, 6 and 7 and the related disclosure.)

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Claims Rejection Under 35 USC - 102

3. Claims 29-34 and 37-50 and 59-82 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Pentax Magnet eyeglass frame** in PTO-1449 filed 6/7/01).

Pentax Magnet eyeglass frame discloses the detachable sunglasses with magnet which comprises a primary lens frame and auxiliary lens frame, the primary spectacle frame includes two temples pivotally coupled to two side extensions and includes two magnetic members embedded in the extensions, the auxiliary spectacle frame includes two legs engaged on the primary spectacle frame and each having a magnetic member for engaging with the magnetic members of the primary spectacle frame.

Claims Rejection Under 35 USC - 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pentax Magnet eyeglass frame** (in PTO-1449 filed 6/7/01).

Pentax Magnet eyeglass frame discloses the detachable sunglasses with magnet which comprises a primary lens frame and auxiliary lens frame, the primary spectacle frame includes two temples pivotally coupled to two side extensions and includes two magnetic members embedded in the extensions, the auxiliary spectacle frame includes two legs engaged on the primary spectacle frame and each having a magnetic member for engaging with the magnetic members of the primary spectacle frame. Although the Pentax Magnet eyeglass frame device does not teach the exact axis of the magnet members as that claimed by Applicant, the axis differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. Additionally, the Applicant has presented no discussion in the specification which convinces the Examiner that the particular axis of the magnet member is anything more than one of numerous axis a person of ordinary skill in the art would find obvious for the purpose of providing support. *In re Dailey*, 149 USPQ 47 (CCPA 1976). It

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appears that these changes produce no functional differences and therefore would have been obvious.

Claims Rejection, Obviousness Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 29-~~50~~ and 59-89 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,149,269

Madison. Although the conflicting claims are not identical, they are not patentably distinct from each other because the disclosures of both application and the patent are directed to an eyeglass having magnetically held auxiliary lenses which comprises an uniblock of which a portion forms a housing for a magnet adapted to secure an auxiliary lens in place over the primary lens.

Response To Argument

6. Applicant's arguments filed 3/19/02 have been fully considered but they are not persuasive.

Applicant argued that Chao does not disclose "an attachment housing connected to the first lens **and extending to a side of the first lens different from the temple**" as recite in claim 83. This argument is not persuasive because figure 6 of Chao shows that the an attachment housing (11) connected to the first lens (10) and extending to a side of the first lens 910) different from the temple (12). Thus the claimed invention does not distinguish over the Chao reference.

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7. Applicant's arguments with respect to claims 29-~~50~~ and 59-82 have been considered but are moot in view of the new ground(s) of rejection.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.


Hung Xuan Dang
Primary Examiner